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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/935,668	08/24/2001	Yasushige Nakamura	011071	1050

23850 7590 02/13/2003

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EXAMINER

NOTE, JANIS L

ART UNIT	PAPER NUMBER
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1756

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DATE MAILED: 02/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.



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Below is a communication from the EXAMINER in charge of this application
COMMISSIONER OF PATENTS AND TRADEMARKS

ADVISORY ACTION

THE REPLY FILED FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.
Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check only a) or b)]

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
b) ☐ In view of the early submission of the proposed reply (within two months as set forth in MPEP § 707.07(f)), the period for reply expires on the mailing date of this Advisory Action, OR continues to run from the mailing date of the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will be entered upon the timely submission of a Notice of Appeal and Appeal Brief with requisite fees.
3. ☒ The proposed amendment(s) will not be entered because:
(a) ☒ they raise new issues that would require further consideration and/or search. (see NOTE below);
(b) ☒ they raise the issue of new matter. (see NOTE below);
(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE:

see attached, paragraph 1

4. ☐ Applicant's reply has overcome the following rejection(s): _____
5. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
6. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached, paragraph 2
7. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
8. ☒ For purposes of Appeal, the status of the claim(s) is as follows (see attached written explanation, if any):
Claim(s) allowed: _____
Claim(s) objected to: _____
Claim(s) rejected: 1-17
Claim(s) withdrawn from consideration: _____
9. ☐ The proposed drawing correction filed on _____ a) ☐ has b) ☐ has not been approved by the Examiner.
10. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
11. ☒ Other: attached

Janis L. Dote
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PRIMARY EXAMINER
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1. The proposed amendments to claims 1, 7, and 11, filed in the amendment filed after the final rejection on Jan. 30, 2003, Paper No. 7, deleting the limitations that the first polyester resin is a "non-linear" polyester and that the second polyester resin is a "linear" polyester, raise new issues because the claims do not require that the first polyester be a non-linear polyester resin and that the second polyester be a linear polyester resin. In other words, the first and second polyester resins can be either linear or non-linear resins. Such broadly recited polyester resins were not present in the claims when the final rejection was mailed.

The proposed amendments also raise the issue of new matter and rejections under 35 U.S.C. 112, first paragraph, for lack of written description in the originally filed specification. As discussed in the final rejection mailed on Sep. 30, 2002, Paper No. 6, paragraph 7, throughout the originally filed specification, the specification only discloses a polyester resin comprising a first non-linear polyester resin having a softening point Tsp of not lower than 120°C and lower than 170°C, and a second non-linear polyester resin having a softening point Tsp of not lower than 80°C and lower than 110°C. The recitations of a "first polyester . . . having a softening point Tsp . . . " and a "second polyester . . . having a softening point Tsp . . . " are

broader than the originally disclosed non-linear polyester resins because they include linear polyester resins.

The proposed cancellation of claims 2, 8, and 12 raises rejections of claims 3-6, 9, 10, 13, and 14 because said claims are multiple dependent claims that depend from claims 2, 8, and 12, respectively.

Contrary to applicants' statement in Paper No. 7, page 6, lines 12-13, that claims 2, 8, and 12 "were indicated as allowable by the Examiner," the indicated allowability of claims 2, 8, and 12, set forth in the first office action, was withdrawn in the final rejection. See Paper No. 6, paragraph 5. Moreover, proposed twice-amended claims 1, 7, and 11 filed in Paper No. 7 do not recite all the limitations recited in originally filed claims 1, 2, 7, 8, 11, and 12.

2. The examiner's refusal to enter the amendment-filed-after-final rejection in Paper No. 7 renders applicants' arguments moot regarding said amendment.